

Remarks

Claims 1-3, 30-33, 62-65, 93-96, and 123-125 are pending in the referenced application by the present amendment. Claims 4-28, 34-60, 66-91, 97-121, and 126-180 have been cancelled without prejudice or disclaimer. Claim 65 has been amended. The specification has been amended to correct minor typographical errors. No new matter enters by the foregoing amendments. Support for the amendments may be found throughout the specification and in the original claims, including for example at page 3, line 27 through page 4, line 15, and in the Examples.

I. Election/Restriction Requirement

Applicants acknowledge the finality of the restriction requirement and maintain their traversal. To facilitate prosecution, Applicants have cancelled the non-elected claims, namely claims 4-29, 34-61, 66-92, 97-122, and 126-180, without prejudice or disclaimer.

II. Specification Objection

The Office has objected to the disclosure because “...the term ‘GS-7340’ is misspelled as ‘GS-GS-7340’ in line 22 on page 1691” Office Action, page 4. To facilitate prosecution, Applicants have amended the specification at page 1691, lines 13-25 to recite “GS-7340”. Applicants have also amended the specification at page 1691, lines 13-25 by inserting spaces between numbers and units. As such, Applicants respectfully request withdrawal of the objection to the specification.

III. Rejection Under 35 U.S.C. § 112, Second Paragraph, Indefiniteness

Claims 30-33, 62-65, 93-95, and 123-125 stand rejected as allegedly indefinite because the claims “employ the enzyme, GS-7340 ester hydrolase, which is an arbitrary name” and “the term GS-7340 has already been used in the art to name a prodrug for PMPA.” Office Action, pages 4-5. Applicants respectfully traverse this rejection.

In assessing definiteness, a claim must be read in light of the specification and the knowledge of a person skilled in the art. *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U.S. 403, 432, 437 (1902). Thus, "[t]he test for definiteness is whether one skilled in the art would understand the bounds of the claim when read in light of the specification." *Miles Labs., Inc. v. Shandon Inc.*, 997 F.2d 870, 875 (Fed. Cir. 1993), *cert. denied*, 510 U.S. 1100 (1994).

Applicants respectfully submit that the term "GS-7340 Ester Hydrolase" would be clear to one of ordinary skill in the art when read in light of the specification. For example, the specification refers to a "PMBC enzyme which we designate GS-7340 Ester Hydrolase". *See, e.g.*, specification, page 3, line 19). Moreover, the specification details "[p]urification of the Enzyme(s) responsible for the cleavage of GS-7340...." Specification, page 1690, lines 7-8. For example, the specification recites extraction of GS-7340 ester hydrolase, anion exchange chromatography, hydrophobic interaction chromatography, hydroxyapatite chromatography, high resolution gel filtration chromatography, and a purification summary of GS-7340 ester hydrolase. *See e.g.*, specification at pages 1691-1694.

In addition, the specification provides characteristics of GS-7340 ester hydrolase such as for example ester hydrolase activity and reduced non-specific esterase activity versus alpha napthyl acetate. *See e.g.*, specification at pages 1690-1691, 1694 (Table 1c). Moreover, the specification provides details of the biochemical characterization of GS-7340 ester hydrolase. *See e.g.*, Specification at pages 1694-1698. For example, the specification recites determination of isoelectric point, inhibition by multiple serine hydrolase inhibitors, and molecular weight of GS-7340 ester hydrolase on gel filtration. *See id.* As such, one of ordinary skill in the art would understand the meaning of GS-7340 ester hydrolase when read in light of the specification.

Based on the foregoing, Applicants respectfully request withdrawal of this rejection.

IV. Rejection Under 35 U.S.C. § 102(b)

Claims 1-3 and 96 stand rejected as allegedly anticipated by Eisenberg *et al.* (2001). Applicants respectfully traverse this rejection.

In order to anticipate under 35 U.S.C. § 102(b), a prior art reference must have been published more than one year prior to the date of application for patent in the United States.

Applicants claim the benefit of the filing date of April 26, 2002. As such, the publication date of a reference under 35 U.S.C. § 102(b) must be on or before April 25, 2001.

Eisenberg *et al.* was published in Nucleosides, Nucleotides & Nucleic Acids, 20(4-7), 1091-1098 (2001), where 20 refers to the volume number and 4-7 refers to the issues contained therein. Issues 4-7 refer to issues from the fourth through the seventh months of the year, namely from April through July. As such, the Office has provided no evidence that the publication of Eisenberg *et al.* in Volume 20 together with issues through and including the July issues came before April 26, 2001. On the basis of the foregoing, Applicants respectfully submit that Eisenberg does not anticipate under 35 U.S.C. § 102(b) and this rejection should be withdrawn.

Conclusion

In view of the foregoing remarks, Applicants respectfully request withdrawal of the outstanding rejections and timely allowance of the pending claims. If the Examiner believes that a telephone conference would be useful in resolving any outstanding issues, she is invited to call Applicants' undersigned representative at (202) 942-5325.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Lisa A. Adelson".

David R. Marsh (Reg. No. 41,408)
Suet M. Chong (Reg. No. 38,104)
Lisa A. Adelson (Reg. No. 51,204)

Date: June 21, 2006

ARNOLD & PORTER LLP
Attn: IP Docketing
555 Twelfth Street, NW
Washington, D.C. 20004
(202) 942-5000 telephone
(202) 942-5999 facsimile